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SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1930

No. 68

MILLER BROTHERS COMPANY
Petitioner

v.

LEKTOPHONE CORPORATION
Respondent

REPLY BRIEF OF PETITIONER

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Supreme Court of the United States

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MILLER BROTHERS COMPANY, *Petitioner,* v. LEKTOPHONE CORPORATION, *Respondent.*	No. 68

REPLY BRIEF OF PETITIONER.

It is believed to be necessary to present this reply to Respondent's brief because, rather than meet and clarify the issues raised by the Petitioner's brief, Respondent has, apparently, chosen to avoid and becloud them. Effort will be made, however, to discuss only the points not fully covered by our main brief.

The Hopkins Invention.

Respondent, relying upon its discussion and argument on the subject in its brief in the *Rolla* case, asserts (Brief, pp. 4 and 5) that the Hopkins invention is a three element mechanical combination comprising—

(1) "a large, light, stiff, paper cone coupled by an"

(2) "annular, plane peripheral rim to"

(3) "a rigid, encircling frame."

The assertion is made that this three element combination results "in a practical direct acting loud speaker having a *new* mode of operation and a *new* result"* (Respondent's brief, p. 5). The assertion is also made (Respondent's brief, p. 5) "that the invention lay in the *new combination*, not in the selection of the rim material." Counsel for the Lektophone Company quite frankly admitted in open Court in the Court below, and will no doubt make the same frank admission before this Court, that *the same combination of the same three elements* is found in the prior art.

It is, of course, unnecessary to rely upon admissions heretofore made by counsel in argument, or upon an expectation of a repetition thereof before this Court. We have merely to refer to the structures of the prior art to completely prove the fact. It is, of course, immaterial whether the cone sound reproducers of the prior art are made of *paper* or some other light, vibratile material. This is so because the claims of the patent are silent as to the material to be employed for the tympanum. On page 2 of the patent (Rec. p. 318, line 74) the tympanum is described as being of "light, vibratile material." On page 3 of the patent (Rec. p. 319, line 10) the material is described as "compressed fibrous material, such as hot pressed paper or *fibre*." At line 7, page 2 of the patent, the material of the tympanum is stated to preferably be a "colloidal" substance.† In the parent application as originally filed, the material of the tympanum was described in the following language (Rec. pp. 344-345):

> "Compressed fibrous material, such as hot pressed paper or fibre, has been found to act satisfactorily,

* Italics in this brief are ours.
† Celluloid, for example, is a colloidal substance.

> *but I* ***prefer*** *hard rubber or vulcanite* as it is more easily handled, is less affected by weather conditions and lends itself to the production of a more finished product."†

From the foregoing it will be readily seen that the alleged invention of the patent, as well as the claims thereof, are not concerned with the *material* of the tympanum.

With this established, we point out the numerous instances of the prior art where the so-called "three element mechanical combination" of Hopkins is illustrated and fully described in a sound reproducing device.

(A) The Dann and Lapp patent No. 338,660 of 1886 (Rec. p. 476) shows the light vibratile tympanum comprising (1) the cone *a* coupled by (2) an annular, plane peripheral rim A, to (3) a rigid, encircling frame *m*.

(B) The Stroh British patent No. 3393 of 1901 (Rec. p. 482) shows the same three element combination, viz.: (1) the vibratile sound reproducer cone (*a* of Fig. 1, a^1 of Fig. 2, a^2 of Fig. 3), each coupled by (2) an annular plane peripheral rim to (3) a rigid encircling frame.

(C) Kraemer patent No. 890,142 of 1908 (Rec. p. 483) also shows the identical three element combination consisting of (1) the vibratile cone (15), having (2) an annular peripheral rim coupled to (3) a rigid encircling frame.

(D) English patents No. 1,064,062 of 1913 and No. 1,192,289 of 1916 (Rec. pp. 509 and 515), each illustrate the identical three element mechanical combination consisting of (1) a vibratile cone coupled by (2) an annular plane peripheral rim to (3) a rigid encircling frame.

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† See Record pp. 222-226, beginning at quoted XQ35.

(E) Elfering patent No. 1,182,078 of 1916 (Rec. p. 520), shows (1) the cone with its (2) annular plane peripheral rim. While this patent does not show the encircling rigid frame, it points out (p. 1, line 100):

> "It is well known that in diaphragms wherein *the margin is engaged in a sound box,* and the intermediate portion is free to vibrate to reproduce sound, the central portion which is connected with the stylus bar is afforded the maximum vibration, while the surface intermediate of the central portion and the periphery vibrates with varying force diminishing toward *the margin of the diaphragm which is engaged.*"

(F) Brown British patents No. 29,833 of 1910 (Rec. p. 527) and No. 1157 of 1911, each show the same three element mechanical combination, comprising (1) a vibratile cone coupled by (2) an annular plane peripheral rim to (3) a rigid encircling frame.

(G) Maxwell patent No. 216,051 of 1879 (Rec. p. 473), also shows the three element mechanical combination consisting of (1) the vibratile cone B, coupled by (2) an annular peripheral rim, to (3) a rigid encircling frame A (in this instance the rim is tacked, riveted, or otherwise permanently affixed to the frame).

(H) Watts and Maxwell patent No. 237,712 of 1881 (Rec. p. 543), shows the same combination wherein (1) the vibratile cone B is coupled by means of (2) an annular plane peripheral rim to (3) a rigid encircling frame by means of tacks or the like g.

From the foregoing it will be quite apparent that if, as Respondent's counsel assets (brief p. 5) Hopkins' invention "lay in the new combination" of the three elements,

then the patent is completely anticipated and is entirely devoid of novelty because the *same* three elements, used in the *same* combination, each performing its *same* respective function in the *same* way, is found in every instance of the prior art to which attention has been called. Nor can this conclusion be escaped by counsel's mere unsupported assertion that the Hopkins three element combination resulted in a loud speaker "having a *new* mode of operation and a *new* result." What, it is queried, is the *new* mode of operation? What, it is queried, is the *new* result? The mode of operation of the Hopkins phonograph reproducer is that vibrations caused by the needle traveling in the groove of a phonograph record are imparted to the apex of the cone. These vibrations, in turn, cause the cone to vibrate, thereby setting up sound waves (See Respondent's brief in *Rola* case, p. 14). Identically the same action *unavoidably* takes place in every instance of the same combination in the art above set forth. Not only is it obvious that the mode of operation is identical, and of necessity must be, but it is equally obvious that the *results* are identical. The vibration of the conical diaphragm of Hopkins sets up audible air waves. The identical three element combination of the prior art unavoidably does the same thing. Sound waves are sound waves irrespective of whether they are regenerated by Hopkins or by Dann and Lapp, English, Brown, Stroh, etc.

With these facts so apparent on a moment's consideration, what, it is again queried, is left for Hopkins to claim as an invention? We submit that the answer is—*nothing*. The only *physical* difference between what Hopkins has claimed and what is shown in the art, in so far as we are here concerned, is the *size* of his vibratile tympanum. Variation in size, however, does not, as erroneously urged by Respondent's counsel, effect a different *mode of opera-*

tion or a different *result*. A difference in *degree* of result (for example, as in volume or range) is no basis for the unqualified assertion that has been made in counsel's brief in behalf of Respondent.

Thus, the only difference that exists between Hopkins and the identical structures of the prior art is in the *size* of his tympanum. This fact was recognized by the Patent Office, as evidenced by the file history of the case, and the persistent rejection of the claims. It was likewise recognized by Hopkins in the prosecution of his application, in the patent as issued, and in his testimony when he appeared as a witness in litigation brought on his patent (see our main brief, p. 38). Indeed, as is made clear by the patent and its file history (and so held by the Courts in the Sixth and Ninth Circuits), the *minimum size* of the vibratile tympanum was made the *essence* of the invention. Obviously, there was no patentable *novelty* in an increased *size* of device, where the three element combination remained identical in structure, function and operation. This is especially so in view of the Lumiere patents (Rec. pp. 486, 497), where tympanums well above the minimum size specified by the Hopkins patent are disclosed with the same plane annular rim rigidly fastened to an encircling supporting frame. The Fada structures, being smaller than the minimum size of the Hopkins patent, quite obviously, do not infringe the patent even if, by any interpretation, validity can be found therefor.

Section 4897 R. S.

(Respondent's brief, pp. 7-17.)

We have little to add to what we have said in our main brief on this subject. We desire, however, to point out that only one case of those cited by the District Court

in support of its conclusion (as opposed to Petitioner's contention) had to do in any respect with the provisions of Section 4897 R. S. In that one case (*Diamond etc. Co.* v. *The Bayer Co.*, 13 Fed. [2] 337) the patent, the validity of which was attacked, was sustained by the Court expressly because *the renewal of the forfeited application was filed within the two years provided by the statute.* Neither the Court below nor Respondent has cited any instance where a renewed application, filed *after* the expiration of the statutory period of Section 4897 R. S., has been held to be valid.

The controlling facts of the case at bar, which differentiate the present case from all those cited by Respondent and the Court below, are:

(1) Claims directed to the subject-matter of the patent in suit were allowed in the parent application.

(2) The application was forfeited for non-payment of the required fee.

(3) *Before* the expiration of the statutory period of Section 4897 R. S. the *first renewal* application was filed.

(4) *Before* the expiration of the statutory period *the claims directed to the subject-matter of the patent in suit were* ***voluntarily canceled.***

(5) **After** the expiration of the statutory period provided by Section 4897 R. S. *the application for the patent in suit was filed. This constituted the* ***second*** *renewal.*

The case of *Dwight & Lloyd* v. *Greenowalt*, 27 Fed. (2) 823, was cited by Petitioner to show an express holding that with respect to Section 4897 R. S. the filing of a divisional application in and of itself constitutes a "*renewed*" application, under the statute, for the subject-matter of the divisional application.

There can be no doubt but that the filing of the divisional application for the patent in suit, *at a time when there was no claim directed to that subject-matter pending before the Patent Office*, constituted a *renewal* of the application. In fact, it was the *second* renewal. In law, it was barred by statute.

In a footnote on page 9 of Respondent's brief, comment is made to the effect that Hopkins' procedure of voluntarily dividing out the subject-matter of the patent in suit from his parent application, was not adopted with any ulterior purpose. This is wholly inconsistent with the argument that is advanced on pages 36 and 37 of Respondent's brief, where it is *pointed out* that although the parent application, as filed and issued, was expressly limited by the language of its specification to the *phonograph art* (to which the file history and language of the claims properly limited the alleged invention), the patent in suit has been *intentionally* expanded beyond Hopkins' original invention so as to include reproduction of sounds, not only from phonograph records, *but from "other element subjected to the action of such sounds," as well.*

On Criticisms of Petitioner's Brief.

(Respondent's brief, pp. 17-24.)

1. The Annular Rim (Respondent's brief, pp. 17-21).

The difference in the annular rim of the Fada loud speakers and that of the Hopkins patent is, we submit, of considerable importance in this controversy. That is so for these reasons:

(a) The claims of the Hopkins patent assert that it is the *tympanum* which must exceed 9 inches in diameter.

and which must be clamped at its periphery to the annular rim. The specification of the patent makes it perfectly clear that it is the *tympanum* that must be made of "light, vibratile material" capable of regenerating sounds. The light vibratile material capable of regenerating sounds, in the Fada structures, is *less* than 9 inches in diameter, and is *not* rigidly clamped at its periphery. Of course, Respondent's whole hope of success in this litigation is dependent upon its ability to have this Court consider this a "trifling point." It is believed that the Court will not be disposed to pass by, as lightly as counsel for Respondent does for want of a convincing answer, a dispositive fact in the litigation.

The vibratile rim of the Hopkins patent actually *does* give off sound waves. The Court of Appeals for the Second Circuit called it (in the *Sylo* case) a "sounding rim." It is truly—as correctly described in the patent—*part of the tympanum.* Not only does the cloth rim of the Fada structures *fail* to give off audible sound waves, it actually *absorbs* the sound waves (Rec. pp. 42-43), which is, of course, the direct antithesis.

2. The Support (Respondent's brief, p. 21).

Under this heading counsel for respondent quite obviously avoids the issue, and engages in a play on words. Inspection of the Hopkins patent discloses that the *entire* and *only* support afforded the tympanum is by the rim. If the rim were removed the tympanum would fall. It is in that sense, and only that sense, that the terms "support," "supported," and "supporting" are used in the Hopkins specification and claims.

In the Fada loud speakers, the cloth rim can be taken away and the vibratile element does not fall. It retains its position and is still operative and useful.

These are simple facts that can and will be demonstrated to the Court by the simple expedient of removing the cloth rim and operating the loud speaker with its rim removed. Of course the cloth rim of the Fada structures would retain the cone in position and prevent sagging due to gravity, should its weight be excessive (which, in fact, it never is), but that is not what is meant by "support" in the Hopkins specification and claims. As above stated, the rim is the *only* support for the Hopkins cone which prevents it from flying to the four winds.

Bodily Movement of the Hopkins Cone (Respondent's brief, p. 33).

Under this heading (Respondent's brief, p. 33) again the issue is avoided, and attempt made to becloud it. Counsel for Respondent develops, what has never been denied, that all vibratile conical sound regenerators vibrate bodily as well as with wave motions. It is, however, the wave motion which is the source of sound. The Court of Appeals for the Third Circuit stated that the Hopkins cone moved bodily *without wave movement.* This assertion was based on the statement contained in the Hopkins patent, as follows (p. 2, line 112, Rec. p. 38):

> "The conical shape is given the tympanum so that shocks or vibrations impressed upon the apex of the cone in a direction towards its base will move the whole cone bodily, the strains being imparted edgewise of the material *and no wave motions being set up in the thin material of the cone.* The curvature of the walls of the cone *precludes the setting up of waves in the material;* and the intended object, the simultaneous movement of the whole conical portion of the tympanum, is thus obtained."

Petitioner has never contended that a cone does not move *bodily* AS WELL AS in waves. The Court of Appeals for the Third Circuit, however, based its opinion on the understanding, as expressly stated in the Hopkins patent, that the cone of Hopkins' invention moved bodily *without* wave movement. Indeed, the Court was under the impression that the function of the rigid frame was, as stated by the patent, to *prevent* wave movement. This understanding of the mode of operation of the Hopkins device (erroneous in scientific fact though it was) was necessary to the Court of Appeals' finding of *novelty* or *invention* for the Hopkins patent. In either case, the record in this litigation conclusively establishes (see, for example, the sand patterns) that the Fada structures do not operate with bodily movement *without wave movement*, but, on the contrary, depend upon the wave movement for the regeneration of sound. The conclusion to be drawn from these facts is believed to be obvious. The Court of Appeals for the Third Circuit found patentable novelty for the Hopkins three-element mechanical combination, because it believed that the Hopkins combination operated in a manner which was different from the operation of the same three-element combinations of the prior art. Whether the Court of Appeals was right or wrong, for the moment, is immaterial, for the result is the same. If the Court of Appeals was wrong (and it is our conviction it was), and there is, in fact, no difference in mode of operation between the Hopkins device and the similar devices of the prior art, the Hopkins patent is invalid for want of patentable novelty. If, on the other hand, the Court of Appeals was right, and the Hopkins device does operate in a manner different from that of the same devices of the prior art, then the Fada structures do not infringe because the Fada structures

operate on the same principles and in the same way as the devices of the prior art. Counsel for Respondent carefully avoided meeting that issue.

The Limitation as to Size (Respondent's brief, pp. 42, *et seq.*).

We need not again traverse the ground covered in our main brief under the heading of infringement. Counsel for Respondent, in his endeavor to avoid the express limitation in the claims of the Hopkins patent as to the 9-inch limitation in size, is merely arguing against the disclosure, language, and file history of the patent in suit.

CONCLUSION.

The Court below should be reversed.

Respectfully submitted,

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October 28, 1930.